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In re Application of
Kararli et al..
Application No.: 10/031,898
PCT No.: PCT/US00/32434
Int. Filing Date: 06 December 2000
Priority Date: 08 December 1999
Attorney's Docket No.: 6794S-000005USC
For: CYCLOOXYGENASE-2 INHIBITOR
COMPOSITIONS HAVING RAPID ONSET OF
THERAPEUTIC EFFECT

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: DECISION ON
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: PETITION
:
: UNDER 37 CFR 1.47(a)
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This is a decision in response to the "PETITION UNDER 37 CFR §1.47(a)" filed on 09 December 2002. The \$130 petition fee has been charged to applicant's deposit account.

BACKGROUND

On 06 December 2000, applicants filed international application PCT/US00/32434 that claimed priority of an earlier United States application filed 08 December 1999. Accordingly, the twenty month period for entry into the national stage in the United States expired at midnight on 08 August 2001.

International application PCT/US00/32434 became abandoned as to the United States at midnight on 08 August 2001.

On 22 January 2002, applicants filed a petition to revive along with a letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a copy of the international application and the basic national fee of \$890 as required by 35 U.S.C. 371(c). These papers were assigned application number 10/031,898.

On 01 May 2002, a decision was mailed to applicant indicating that the petition to revive was granted and that the United States Patent and Trademark Office in its capacity as Elected office would mail the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that applicant was required to file a oath/declaration.

On 07 May 2002, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that applicant was required to file a oath/declaration and the required surcharge fee. The Notice gave a two-month period from the date of mailing of the Notice for which to submit the missing items.

In order to satisfy the requirements of 35 U.S.C. 371(c)(4), on 09 December 2002, applicants filed the following papers:

- 1) a Response to Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) including a Petition under 37 CFR 1.47(a);
- 2) the required petition fee;
- 3) a five month extension of time fee;
- 3) signed statement by Steven J. Sarussi;
- 4) a declaration signed by inventors Tugrul T. Kararli, Mark J. Kontny, Michael J. Hageman and Royal J. Haskell.

On 07 January 2003, the USPTO mailed a "NOTICE OF ABANDONMENT UNDER 37 CFR 1.53(f) OR (g)" (Form PCT/DO/EO/909).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing inventor. The petition is missing item (2) above.

With respect to item (1), applicant included the \$130 petition fee.

With respect to item (2), Mr. Sarussi indicated that he provided inventor Desai a copy of the complete application on at least two occasions. Further, in at least one instance, inventor Desai wrote a letter indicating that he had received it but that he would not review it without payment. On the second occasion that the application was mailed to inventor Desai, via Certified Mail.

With respect to item (3), Mr. Sarussi has indicated inventor Desai's last known address.

With respect to item (4), the joint inventors have submitted a declaration signed on their own behalf and on behalf of inventor Desai.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is **GRANTED**.

The "NOTICE OF ABANDONMENT UNDER 37 CFR 1.53(f) OR (g)" (Form PCT/DO/EO/909) mailed 07 January 2003 is hereby **VACATED**.

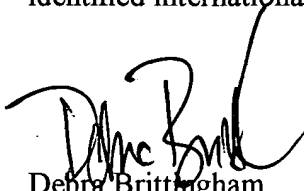
The \$130 petition fee has been **CHARGED** to applicant's **DEPOSIT ACCOUNT # 08-0750**.

The National Stage Processing Branch is authorized to accept the application as a 37 CFR 1.47(a) application and to mail a filing receipt. The application will be given an international filing date of 06 August 2001 under 35 U.S.C. 363, and a date of 09 December 2002 under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

The application is being returned to the National Stage Processing Branch of the Office of PCT Operations for processing as the U.S. National Stage of the above-identified international application.



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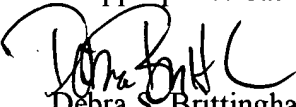
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In re Application of: Kararli, et al.
Application No.: 10/031,898
PCT No.: PCT/US00/32434
Int. Filing Date: 02 December 2000
Attorney's Docket No.: 6794S-000005USC
For: CYCLOOXYGENASE-2 INHIBITOR COMPOSITIONS HAVING RAPID
ONSET OF THERAPEUTIC EFFECT

Dear Dr. Desai:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.


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OFFICIAL GAZETTE NOTICE

37 CFR 1.47 Notice by Publication

Notice is hereby given of the filing of an application with a petition under 37 CFR 1.47 requesting acceptance of the application without the signature of all inventors. The petition has been granted. A notice has been sent to the last known address of the non-signing inventor. The inventor whose signatures is missing (Subhash Desai) may join in the application by promptly filing an appropriate oath or Declaration complying with 37 CFR 1.63. The international application number is PCT/US00/32434 and was filed on 06 December 2000 in the names of Tugrul T. Kararli, Mark J. Kontny, Michael J. Hageman and Royal J. Haskell and Subhash Desai for the invention entitled CYCLOOXYGENASE-2 INHIBITOR COMPOSITIONS HAVING RAPID ONSET OF THERAPEUTIC EFFECT. The national stage application number is 10/031,898 and has a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 09 December 2002.